

Appl. No. 09/922,209
Amdt. dated Mar. 8, 2006
Reply to final Office action of Oct. 4, 2005

REMARKS/ARGUMENTS

Claims 9 and 32-38 are currently pending in the application. Claims 1-8, 10-31 and 39-60 are hereby withdrawn without prejudice as being subject to a restriction requirement. Claims 9 and 32-38 were rejected in the Office action mailed October 4, 2005 (hereinafter referred to as "Office Action"). A completed credit card authorization form is included for the RCE fees and a three month extension of time to respond to the Office Action. It is believed that no other fees are due at this time. In view of the following remarks and amendments, applicant respectfully request a timely Notice of Allowance be issued in this case.

Support for the amendments can be found throughout the application. Applicant respectfully submits that no new matter is added by the amendments.

Restriction Requirement

Claims 1-60 were subject to a restriction requirement because the examiner concluded that the claims are directed to four inventions as follows:

Group I	Claims 1-8, 10-16 and 47-56 classified in class 709, subclass 245;
Group II	Claims 17-20 and 57-60 classified in class 709, subclass 229;
Group III	Claims 21-31 and 39-46 classified in class 726, subclass 2; and
Group IV	Claims 9 and 32-38 classified in class 713, subclass 169.

In accordance with the teleconference with the examiner on September 27, 2005, applicant elects Group IV (claims 9 and 32-38) with traverse. Claims 1-8, 10-31 and 39-60 are hereby withdrawn without prejudice.

Claim Rejections under 35 U.S.C. § 102

Claims 9 and 32-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,529,956 to Smith et al. Applicant respectfully submits that claims 9 and 32-36, as amended, are not anticipated by the cited references and are, therefore, allowable under 35 U.S.C. § 102(e) for the reasons stated below.

For anticipation, a single reference must identically disclose every element of the claimed invention. *Corning Glass Works v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989). A reference that excludes a claimed element, no matter how insubstantial or obvious, is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Smith discloses a document delivery system that allows a corporation, publisher or individual (sender 16) to push documents to consumers (recipients 22). (Fig. 14; Fig. 15; col. 2, lines 13-23; col. 3, lines 26-44; col. 10, line 64-col. 11, line 1; col. 15, lines 17-21). As a result, Smith's binary file delivery system is a new generation of facsimile

Appl. No. 09/922,209
Amdt. dated Mar. 8, 2006
Reply to final Office action of Oct. 4, 2005

technology. (col. 3, lines 50-58). The sender 16 uploads the transaction details (number of files, file size and intended recipients) to the system (col. 7, lines 63-66; col. 15, lines 44-46), which in turn sends an e-mail to the recipients 22 containing a URL indicating the store item ID corresponding to the document that is to be delivered to the recipient 22 (col. 9, lines 10-14; col. 15, lines 51-56). Instead of sending a URL to the recipient, a private URL (PURL) can be sent to the recipient by e-mail. (col. 14, lines 55-61; col. 15, lines 22-25). A URL or PURL is generated for each intended recipient of the document. (col. 15, lines 46-47). The recipient then uses the URL or PURL from the e-mail to download the document from the server. (col. 9, lines 23-38; col. 14, lines 61-62; col. 15, lines 26-29). As will be described below, Smith's system does not identically disclose every element of the claimed invention.

Claim 9

With respect to claim 9, applicant respectfully submits that Smith does not disclose the method recited in claim 9 because the portions of Smith cited by the examiner:

- (a) pertain to the sender (16) of the document, not the recipient (22) (col. 2, lines 26-33; col. 11, lines 39-53; col. 11, lines 62-65; col. 13, lines 60-65);
- (b) occur after the recipient (22) has received the PURL via e-mail (col. 2, lines 33-39; col. 15, lines 57-62; col. 16, lines 15-24); and
- (c) the PURL is sent to the recipient via e-mail, not generated as part of a web page document (col. 15, lines 51-56; col. 16, lines 36-58).

As a result, Smith does not identically disclose every element recited in claim 9. Accordingly, applicant respectfully submits that claim 9 is not anticipated by Smith and is, therefore, allowable under 35 U.S.C. § 102(e).

Similarly, applicant respectfully submits that Smith does not identically disclose the following elements recited in claim 9 for the following reasons:

- (a) *receiving a signal requesting a web page document from a web access device (WAD), the signal including an Internet protocol (IP) address of the WAD* because Smith uses the IP address of the recipient only after the URL or PURL is sent to the recipient via e-mail (col. 16, lines 16-24). At this point in claim 9, the secure URL has not been generated (see step (e)) and the recipient has not received it (see step (f)).
- (b) *retrieving data for the web page document including a universal resource locator (URL) of a document referenced in the web page document* because Smith generates the URL or PURL associated with the recipient and document before it receives a request for the document by the recipient (col. 2, lines 26-34; col. 9, lines 10-14; col. 14, lines 55-67; col. 15, lines 22-29; col. 15, lines 46-58). Moreover, the URL or PURL is included in an e-mail,

Appl. No. 09/922,209
Amtd. dated Mar. 8, 2006
Reply to final Office action of Oct. 4, 2005

not a web page document. (col. 9, lines 10-14; col. 15, lines 14-29; col. 15, lines 51-56).

- (c) *retrieving resource access right data for the URL using the IP address of the (WAD) and/or user name and password established through a log-in procedure* because, in Smith, these functions either pertain to the sender (16) (col. 11, lines 62-65; col. 13, lines 60-65) or occur after the recipient (22) has received the PURL via e-mail (col. 15, lines 57-62; col. 16, lines 15-24). At this point in claim 9, the secure URL has not been generated (see step (e)) and the recipient has not received it (see step (f)).
- (e) *combining the secure resource access right data with the respective URL to generate a secure URL* because, in Smith, the PURL is generated before the recipient requests the document (col. 2, lines 28-34; col. 14, lines 55-62; col. 15, lines 44-58). At this point in claim 9, the recipient has already requested the document (see step (a)).
- (f) *generating the web page document including the secure URL that can be used to generate a request for the document* because, in Smith, the PURL is generated before the recipient requests the document (col. 2, lines 28-34; col. 14, lines 55-62; col. 15, lines 44-58) and the PURL is sent to the recipient via e-mail (col. 15, lines 51-56; col. 16, lines 36-58). The PURL is not generated as part of a web page document. At this point in claim 9, the recipient has already requested the document (see step (a)).
- (g) *transmitting the web page document including the secure URL to the WAD* because, in Smith, the PURL is generated before the recipient requests the document (col. 2, lines 28-34; col. 14, lines 55-62; col. 15, lines 44-58) and the PURL is sent to the recipient via e-mail (col. 15, lines 51-56; col. 16, lines 36-58), not generated as part of a web page document. At this point in claim 9, the recipient has already requested the document (see step (a)).

As a result, Smith does not identically disclose every element recited in claim 9. Accordingly, applicant respectfully submits that claim 9 is not anticipated by Smith and is, therefore, allowable under 35 U.S.C. § 102(e).

Claim 32

With respect to claim 32, applicant respectfully submits that Smith does not disclose the method recited in claim 32 because the portions of Smith cited by the examiner:

- (a) pertain to the sender (16) of the document, not the recipient (22) (col. 13, lines 60-65);
- (b) the PURL is sent to the recipient via e-mail, not generated as part of a web page document (col. 15, lines 51-56; col. 16, lines 36-58); and

Appl. No. 09/922,209
Amdt. dated Mar. 8, 2006
Reply to final Office action of Oct. 4, 2005

(c) the IP address and URL are not used to generate hash data (col. 15, lines 57-62; col. 16, lines 15-24).

As a result, Smith does not identically disclose every element recited in claim 32. Accordingly, applicant respectfully submits that claim 32 is not anticipated by Smith and is, therefore, allowable under 35 U.S.C. § 102(e).

Similarly, applicant respectfully submits that Smith does not identically disclose the following elements recited in claim 32 for the following reasons:

- (a) *receiving a signal requesting access to a resource, the request signal including a universal resource locator (URL), secured resource access right data, and an Internet protocol (IP) address of a device requesting access to the resource, and hash data, wherein the request signal was generated from a web page containing a secure URL combining the hash data, URL and secured resource access right data because, in Smith, the URL or PURL is included in an e-mail, not generated as part of a web page document.* (col. 9, lines 10-14; col. 15, lines 14-29; col. 15, lines 51-56).
- (b) *verifying whether key data is valid based on data corresponding to the key data in a secure content key database because the cited portion of Smith pertains to the sender (16) (col. 13, lines 60-65), not the recipient.*
- (c) *if the key data is verified as valid in step (b), generating hash data based on at least the IP address, URL, and the key data because, in Smith, the IP address and URL are not used to generate hash data (col. 15, lines 57-62; col. 16, lines 15-24) and the cited portion of Smith for step (b) pertains to the sender (16) (col. 13, lines 60-65), not the recipient.*
- (d) *verifying that the hash data generated in the step (c) matches the hash data included in the request signal received in the step (a) because, in Smith, the IP address and URL are not used to generate the hash data in step (c) (col. 15, lines 57-62; col. 16, lines 15-24) and the cited portion of Smith for step (b), which is also used to generate the hash data in step (c), pertains to the sender (16) (col. 13, lines 60-65), not the recipient.*

As a result, Smith does not identically disclose every element recited in claim 32. Accordingly, applicant respectfully submits that claim 32 is not anticipated by Smith and is, therefore, allowable under 35 U.S.C. § 102(e).

Claims 33-36

With respect to claims 33-36, applicant respectfully submits that claims 33-36 depend from claim 32, which is allowable for the reasons stated above, and further distinguishes over the cited references. Accordingly, applicant respectfully submits that claims 33-36 are not anticipated by Smith and are, therefore, allowable under 35 U.S.C. § 102(e).

Appl. No. 09/922,209
Amtd. dated Mar. 8, 2006
Reply to final Office action of Oct. 4, 2005

Claim Rejections under 35 U.S.C. § 103(a)

Claims 37 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith and official notice of using time-based data to create and use keys. Applicant respectfully submits that claims 9 and 32-38 are not obvious in view of the cited references, either alone or in combination, and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

In order to establish a *prima facie* case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, (2) there must be a reasonable expectation of success, and (3) the prior art or combined references must teach or suggest all the claim limitations. MPEP § 2143; *In re Vacek*, 947 F.2d 488 (Fed. Cir. 1991). “The prior art must suggest the desirability of the claimed invention.” MPEP § 2143.01. **Both the invention and the prior art references must be considered as a whole.** MPEP § 2141.02.

Unless the reference(s) teach or suggest all the claim limitations, obviousness cannot be found. MPEP § 2143.03. Further, once an independent claim is found to be non-obvious under 35 U.S.C. § 103, then any claim which depends from that independent claim is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

For the reasons stated previously with respect to claims 9 and 32, applicant respectfully submits that there is no suggestion or motivation in Smith to modify its system to: (1) pertain to the user instead of the sender (col. 2, lines 26-33; col. 11, lines 39-53; col. 11, lines 62-65; col. 13, lines 60-65); (b) receive a request for a document before the PURL is created (col. 2, lines 33-39; col. 15, lines 57-62; col. 16, lines 15-24); or (3) generate the PURL as part of a web page document that is sent to the recipient instead of an e-mail (col. 15, lines 51-56; col. 16, lines 36-58). As a result, applicant respectfully submits that claims 9 and 32-38 are not obvious in view of the cited references, either alone or in combination, and are, therefore, allowable under 35 U.S.C. § 103(a).

Likewise, for the reasons stated previously with respect to claims 9 and 32, applicant respectfully submits that there is no reasonable expectation of success in such modifications to Smith because Smith teaches against such modifications. The system in Smith cannot function properly if the request for a document is received before the PURL is created (col. 2, lines 33-39; col. 15, lines 57-62; col. 16, lines 15-24). As a result, applicant respectfully submits that claims 9 and 32-38 are not obvious in view of the cited references, either alone or in combination, and are, therefore, allowable under 35 U.S.C. § 103(a).

Finally, Smith does not teach or suggest all the claim limitations in claims 9 and 32 for the same reasons stated above. As a result, applicant respectfully submits that

Appl. No. 09/922,209
Amtd. dated Mar. 8, 2006
Reply to final Office action of Oct. 4, 2005

claims 9 and 32-38 are not obvious in view of the cited references, either alone or in combination, and are, therefore, allowable under 35 U.S.C. § 103(a).

Conclusion

For the reasons set forth above, applicant respectfully requests reconsideration by the examiner and withdrawal of the rejections. Applicant submits that claims 9 and 32-38 are fully patentable. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is requested that the examiner contact the undersigned at the telephone number listed below.

Respectfully submitted,

CHALKER FLORES, LLP

By



Daniel J. Chalker

Reg. No. 40,552

Tel.: (214) 866-0001

Fax: (214) 866-0010

2711 LBJ Freeway
Suite 1036
Dallas, Texas 75234